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FILED

SEP 17 2007

RICHARD W. WIEKING
CLERK, U.S. DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

9 UNITED STATES DISTRICT COURT
10 NORTHERN DISTRICT OF CALIFORNIA
11 OAKLAND DIVISION

12 ATMEL CORPORATION, a Delaware
corporation; ATMEL SWITZERLAND, a
corporation; ATMEL FRANCE, a corporation;
and ATMEL SARL, a corporation,

14 Plaintiffs,

15 v.

16 AUTHENTEC, INC., a Delaware corporation,

17 Defendant.

18 Case No. 06 CV 2138 CW

19 **REQUEST FOR INTERNATIONAL
JUDICIAL ASSISTANCE PURSUANT TO
THE HAGUE CONVENTION THE TAKING
OF EVIDENCE ABROAD IN CIVIL OR
COMMERCIAL MATTERS
(HAGUE CONVENTION #20)**

20 IDENTITY AND ADDRESS OF THE APPLICANT:

21 Honorable Elizabeth Laporte
United States District Court for the Northern District of California
22 San Francisco Division
Courtroom E, 15th Floor
450 Golden Gate Avenue
23 San Francisco, CA 94102

24 CENTRAL AUTHORITY OF THE RECEIVING STATE:

25 The Royal Ministry of Justice and Police
Department of Civil Affairs
P.O. Box 8005 Dep
26 0030 OSLO
NORWAY
27 Telephone: 47 2224 5451

1 In conformity with Article 3 of Hague Convention #20, the undersigned applicant has the honor
 2 and judicial authority to submit this request on behalf of the Defendants in the above-entitled action.

3 The United States District Court, for the Northern District of California, by and through the
 4 Honorable Elizabeth Laporte, presents its compliments to the judicial authorities of Norway, and
 5 requests international judicial assistance to obtain evidence to be used in a civil proceeding before this
 6 court in the above-captioned matter.

7 A trial on this matter is currently scheduled to take place in California. This court requests the
 8 assistance described herein as necessary in the interests of justice.

9 Below are the names of all parties in this matter and their representatives:

10	Party	Legal Representative
11	PLAINTIFFS: Atmel Corporation Atmel Switzerland Atmel France Atmel SARL By and through counsel: Denise McKenzie, Esq. Sidley Austin LLP 555 West Fifth Street, Suite 4000 Los Angeles, California 90013-1010 United States of America Telephone (213) 896-6000	Denise McKenzie, Esq. Sidley Austin LLP 555 West Fifth Street, Suite 4000 Los Angeles, California 90013-1010 United States of America Telephone (213) 896-6000
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17	DEFENDANTS: AuthenTec, Inc. By and through counsel: Denise De Mory, Esq. Howrey LLP 525 Market Street, Suite 3600 San Francisco, California, 94105 United States of America Telephone (415) 848-4900	Henry C. Bunsow, Esq. Denise De Mory, Esq. Brian A.E. Smith, Esq. Howrey LLP 525 Market Street, Suite 3600 San Francisco, California, 94105 United States of America Telephone (415) 848-4900 Fax (415) 848-4999
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22 **REPRESENTATIVE TO ACT ON BEHALF OF DEFENDANTS:**

23 It is requested that should contact or correspondence with Defendants in this matter be
 24 required, the following individual is appointed in this matter to represent Defendants:

25 Denise De Mory, Esq.
Howrey LLP
525 Market Street, Suite 3600
San Francisco, California, 94105
United States of America
Telephone (415) 848-4900
Fax (415) 848-4999

1 **ENTITY FROM WHOM EVIDENCE IS REQUESTED:**

2 **SINTEF**
 3 Strindveien 4
 4 NO-7465, Trondheim
 5 Norway
 Telephone 47 73 59 30 00
 Fax: 47 73 59 33 50

6 It is believed that **SINTEF** is a business entity registered to do business in Norway.

7 **SUBJECT MATTER AND RELATIVITY OF THIS REQUEST:**

8 Atmel filed a complaint against AuthenTec, Inc. (“AuthenTec”) in the United States District
 9 Court for the Northern District of California alleging patent infringement (“Atmel Lawsuit”). The two
 10 patents asserted against AuthenTec relate to fingerprint sensors and fingerprint sensing technologies.
 11 Based on documents that AuthenTec has received in this case, AuthenTec believes that the two patents
 12 asserted by Atmel may be invalid due to inventorship by another and/or an on sale bar. AuthenTec
 13 believes that evidence of prior inventorship and/or an on sale bar is in the possession, custody, and
 14 control of **SINTEF**, in part, because Atmel has produced documents authored by the inventor of the
 15 asserted patents referencing **SINTEF**. The requested documents and information from **SINTEF** are
 16 therefore relevant to and necessary for trial of this case.

17 **SPECIFIC REQUESTS:**

18 The District Court respectfully requests that these documents and information be produced
 19 quickly, but if at all possible within 30 days after receipt of this request, at a place and time designated
 20 by the Norwegian court having competent jurisdiction over this request.

21 In view of the foregoing, we therefore request, in the interest of justice, that you issue an order
 22 for the acquisition of the evidence requested below, in accordance with the laws and procedures of the
 23 courts of Norway, and summon the appropriate employee, director, officer or other appropriate
 24 representative of **SINTEF**, in possession or control of the evidence requested, to submit the evidence
 25 requested to a duly appointed authority in Norway, in an expeditious manner, for examination by the
 26 below signed authority.

1 **EVIDENCE TO BE OBTAINED:**2 **A. Definitions.**

3 In addition to the abbreviated terms identified above, for the purposes of this request:

4 (1) the terms "you" and "your" mean **SINTEF**, including, without limitation, all predecessors
5 (merged, acquired, or otherwise), successors, subsidiaries, parents, sisters, partnerships and affiliates
6 thereof, and all directors, officers, agents, employees, attorneys, and other persons acting on their
7 behalf;8 (2) the term "Thompson-CSF" means Thomson-CSF and all predecessors (merged, acquired, or
9 otherwise) successors, subsidiaries, parents, sisters, partnerships and affiliates thereof, including but
10 not limited to IDmatics, Laboratoire Central de Recherches, and Thomson-CSF Semiconducteurs
11 Specifiques and all directors, officers, agents, employees, attorneys, and other persons acting on their
12 behalf;13 (3) the term "IDEX" means IDEX and all predecessors (merged, acquired, or otherwise)
14 successors, subsidiaries, parents, sisters, partnerships and affiliates thereof, and all directors, officers,
15 agents, employees, attorneys, and other persons acting on their behalf;16 (4) the term "STMicroelectronics" means STMicroelectronics and all predecessors (merged,
17 acquired, or otherwise) successors, subsidiaries, parents, sisters, partnerships and affiliates thereof, and
18 all directors, officers, agents, employees, attorneys, and other persons acting on their behalf;19 (5) the term "Atmel" means Atmel Corporation, Atmel SARL, Atmel France, Atmel
20 Switzerland, Atmel Grenoble and all predecessors (merged, acquired, or otherwise), successors,
21 subsidiaries, parents, sisters, partnerships and affiliates thereof, and all directors, officers, agents,
22 employees, attorneys, and other persons acting on their behalf.23 (6) the term "Thales" means the Thales Group and all predecessors (merged, acquired, or
24 otherwise), successors, subsidiaries, parents, sisters, partnerships and affiliates thereof, and all
25 directors, officers, agents, employees, attorneys, and other persons acting on their behalf.26 (7) the term "fingerprint sensor" means all mechanical, electronic, optical, electro-optical,
27 capacitive, reflection, RF, pressure, temperature, ultrasound, and micro-electro-mechanical systems

1 and devices designed to read a fingerprint for authenticating individuals, including but not limited to
 2 all prototypes and experiments related to such sensors and further including but not limited to strip
 3 and/or swipe sensors;

4 (8) the term "fingerprint sensing technologies" means all hardware, software, and other
 5 components that may be incorporated into or work in conjunction with a fingerprint sensor, including
 6 but not limited to electronic circuitry, microchips, elements, conductive layers, and algorithms, further
 7 including but not limited to image stitching algorithms;

8 (9) the word "document" includes any written, printed, typed, recorded, computerized,
 9 electronic, taped, graphic, or other matter, in whatever form, whether in final or draft, including but not
 10 limited to all materials that constitute "writings," "recordings," "photographs," "source code" or
 11 "executable code" within the broadest meaning of Rule 1001 of the Federal Rules of Evidence and all
 12 materials that constitute "documents" within the broadest meaning of Rule 34 of the Federal Rules of
 13 Civil Procedure. The word "document" includes, without limitation, printed matter, electronic mail,
 14 materials stored on computer hard drives, diskettes, tapes, any other computer media, and any other
 15 information stored magnetically, optically or in any electronic medium and/or form;

16 (10) the term "communication" includes, without limitation, communications by whatever
 17 means transmitted (i.e., whether oral, written, electronic or other methods used), as well as any note,
 18 memorandum or other record thereof;

19 (11) the term "FingerChip" means the fingerprint sensor manufactured by the Atmel
 20 Corporation, including but not limited to fingerprint sensing technologies developed by Jean-Francois
 21 Mainguet and incorporated into the FingerChip product.

22 (12) the term "SmartFinger" means the fingerprint sensing technologies developed by **SINTEF**
 23 in cooperation with companies named IDEX and STMicroelectronics.

24 **B. Documents requested.**

25 The District Court requests the production of the following documents, which are in the
 26 possession, custody, or control of **SINTEF**:

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 28

1 1. Documents relating to or referring to your communications prior to January 1, 1999 with
 2 IDEX and/or STMicroelectronics concerning fingerprint sensors and/or fingerprint sensing
 3 technologies, including but not limited to SmartFinger.

4 2. Documents relating to or referring to part or prototype number IF120 and dated before
 5 January 1, 1999, including but not limited to all documents concerning the design, development, and
 6 testing of part or prototype number IF120.

7 3. Documents relating to or referring to United States Patent No. 6,289,114 ("the '114 patent")
 8 or United States Patent No. 6,459,804 ("the '804 patent") titled "Fingerprint-Reading System."

9 4. Documents relating to or referring to fingerprint sensors and/or fingerprint sensing
 10 technologies consisting of: (1) sensors with a surface area smaller than the surface area of a finger,
 11 and/or (2) combining partial fingerprint images to create a more complete fingerprint image, and/or (3)
 12 collection of fingerprint data by movement of a finger over a fingerprint sensor, including but not
 13 limited to publications, articles, patents, patent applications, schematics, lab notebooks, and manuals.

14 5. Documents relating to or referring to communications prior to June 5, 1997 between you
 15 and Jean-Francois Mainguet, or any other person employed by or associated with Thomson-CSF,
 16 concerning fingerprint sensors and fingerprint sensing technologies, including but not limited to
 17 FingerChip and SmartFinger.

18 6. Documents relating to or referring to communications between you and Thomson-CSF,
 19 Atmel, and/or Thales concerning licensing, offers to license, infringement, invalidity and/or that affect
 20 in any way rights related to the '804 patent and/or the '114 patent.

21 The documents and information requested above are for use as evidence in the Atmel Lawsuit,
 22 including for use at trial. This Court makes this request to secure production of documents and
 23 information from SINTEF which resides in the jurisdiction of Norway, and this Court confirms that
 24 this is proper and necessary to request since it relates to AuthenTec's counterclaims and defenses and
 25 is necessary for a fair resolution of issues at trial.

26 It is requested that should any portion of this request be denied on legal grounds, that such
 27 denial not affect the remainder of this request.

1 It is requested that any evidence produced be marked, attested, properly sealed by the
 2 appropriate authorities of Norway and returned through appropriate channels to the below signed
 3 authority.

4 Defendant AuthenTec, through counsel Howrey LLP (525 Market Street, Suite 3600, San
 5 Francisco, California 91405, United States of America, Telephone: (415) 848-4900), will reimburse
 6 the appropriate judicial authorities in Norway for all costs incurred in executing the below signed
 7 judicial authority's request for international judicial assistance.

8 When required, the below signed judicial authority shall provide reciprocal assistance, such as
 9 requested herein, to the appropriate judicial authorities of Norway.

10 The United States District Court for the Northern District of California extends the assurance of
 11 its highest consideration to the judicial authorities of Norway.

12 Date of Request: Sept 17, 2007.

13 By:

14 
 15 HON. ELIZABETH LAPORTE
 16 UNITED STATES DISTRICT COURT JUDGE
 17 United States District Court
 18 Northern District of California
 19 San Francisco Division
 20 Courtroom E, 15th Floor
 21 450 Golden Gate Avenue
 22 San Francisco, CA 94102

23 [Seal]